

SERIAL NO. 10/626,452

REMARKS

Claim 4 was objected to because the reference to oils was not clear.

Accordingly, Applicant has amended this claim as kindly suggested by the Examiner.

Claims 1-5 and 8 were rejected under 35 U.S.C. 102(e) on O'Halloran; and claims 1-7 on Edens. The Examiner has stated that these references disclose related compositions. Applicant respectfully traverses the Examiner's rejection on these references. However, in order to narrow the issues present herein, Applicant has amended claim 1 to include the limitations of claims 2, 5, 6 and 8. As now claimed, the invention is directed to a novel and useful emulsion composition of PVA which forms a thin, soft, flexible and readily peelable PVA film upon drying on skin, with clearly defined constituents and the amounts of each present and, in particular, 0.5-10 wt. % of a thickener which is composed of 60 parts sodium polyacrylate, 30-38 parts of an oil, and 4-8 parts of an emulsifier. This thickener is available commercially as RapiThix™ A-60 (International Specialty Products). The invention composition has a pH of about 3-8, and a Brookfield viscosity of 10,000 to 300,000 cps, preferably 20,000 to 80,000 cps (claim 7). The preferred amount of (a) is 5-15% and (b) is 0.8-5[^] (claim 3).

The presence of RapiThix™ in the composition provides a thin, soft and flexible PVA film which can be readily peeled off, and is particularly suitable for use as a face mask, or a patch, on skin, and it can easily deliver an active ingredient such as a cosmetic or drug during application. The O'Halloran reference is seen to merely describe a typical semi-liquid gel or roll-on composition of PVA for forming a peelable cosmetic film with a pullulan ingredient. However, none of the compositions disclosed or suggested therein are emulsion compositions containing RapiThix™ whose oil component in the defined formulation enables the composition to be easily applied and peeled off, without discomfort to the user.

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Claims 6 and 7, relating to the defined viscosity of the composition, are now included in amended claim 1, as is the RapiThix™ formulation of claim 8.

Reconsideration is respectfully requested.

Claims 1-8 also were rejected under 103(a) on the same references, and in view of Zhang, which disclosed a peelable foam coating for a painted surface. However, none of these cited references, alone or in combination, provide the novel and improved emulsion composition as defined in amended claim 1 herein, particularly with respect to the RapiThix™ ingredient, to enable soft application and readily peelability.

Reconsideration is respectfully solicited.

Applicant wishes to call to the Examiner's attention the results of the PCT International Preliminary Report on patentability in which U.S. 6,440,431 to Yoshida (attached) was cited. This patent, however, is cumulative to those already considered herein.

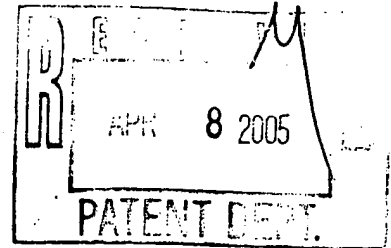
Respectfully submitted,



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Atts. Yoshida US 6,440,431
International Search Report

PATENT COOPERATION TREATY



From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

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PCT

NOTIFICATION OF TRANSMITTAL OF
INTERNATIONAL PRELIMINARY
REPORT ON PATENTABILITY
(Chapter II of the Patent Cooperation Treaty)

(PCT Rule 71.1)

Date of mailing
(day/month/year)

06 APR 2005

Applicant's or agent's file reference

FDN-2809

IMPORTANT NOTIFICATION

International application No.

International filing date (day/month/year)

Priority date (day/month/year)

PCT/US04/20862

29 June 2004 (29.06.2004)

24 July 2003 (24.07.2003)

Applicant

ISP INSTRUMENTS INC.

1. The applicant is hereby notified that this International Preliminary Examining Authority transmits herewith the international preliminary report on patentability and its annexes, if any, established on the international application.
2. A copy of the report and its annexes, if any, is being transmitted to the International Bureau for communication to all the elected Offices.
3. Where required by any of the elected Offices, the International Bureau will prepare an English translation of the report (but not of any annexes) and will transmit such translation to those Offices.
4. **REMINDER**

The applicant must enter the national phase before each elected Office by performing certain acts (filing translations and paying national fees) within 30 months from the priority date (or later in some Offices)(Article 39(1))(see also the reminder sent by the International Bureau with Form PCT/IB/301).

Where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability. It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned.

For further details on the applicable time limits and requirements of the elected Offices, see Volume II of the *PCT Applicant's Guide*.

The applicant's attention is drawn to Article 33(5), which provides that the criteria of novelty, inventive step and industrial applicability described in Article 33(2) to (4) merely serve the purposes of international preliminary examination and that "any Contracting State may apply additional or different criteria for the purposes of deciding whether, in that State, the claimed invention is patentable or not" (see also Article 27(5)). Such additional criteria may relate, for example, to exemptions from patentability, requirements for enabling disclosure, clarity and support for the claims.

Name and mailing address of the IPEA/ US

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PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference FDN-2809	FOR FURTHER ACTION		See Form PCT/IPEA/416
International application No. PCT/US04/20862	International filing date (day/month/year) 29 June 2004 (29.06.2004)	Priority date (day/month/year) 24 July 2003 (24.07.2003)	
International Patent Classification (IPC) or national classification and IPC IPC(7): A61K 7/00 and US Cl: 424/401, 78.03			
Applicant ISP INSTRUMENTS INC.			
<p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <u>4</u> sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input type="checkbox"/> (sent to the applicant and to the International Bureau) a total of <u> </u> sheets, as follows:</p> <p style="margin-left: 40px;"><input type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis of this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p style="margin-left: 40px;"><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) <u> </u>, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p>			
<p>4. This report contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the report</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input checked="" type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability, citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input type="checkbox"/> Box No. VIII Certain observations on the international application</p>			
Date of submission of the demand 13 January 2005 (13.01.2005)		Date of completion of this report 09 March 2005 (09.03.2005)	
Name and mailing address of the IPEA/ US Mail Stop PCT, Attn: IPEA/US Commissioner for Patents P.O. Box 1450 Alexandria, Virginia 22313-1450 Facsimile No. (703) 305-3230		Authorized officer Lakshmi S. Channavajjala Telephone No. 703-308-1235	

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/US04/20862

Box No. I Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ This report is based on translations from the original language into the following language _____, which is the language of a translation furnished for the purposes of:

- ☐ international search (under Rules 12.3 and 23.1(b))
- ☐ publication of the international application (under Rule 12.4)
- ☐ international preliminary examination (under Rules 55.2 and/or 55.3)

2. With regard to the elements of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report):*

☒ the international application as originally filed/furnished

☒ the description:

pages 1-7 as originally filed/furnished

pages* NONE received by this Authority on _____

pages* NONE received by this Authority on _____

☒ the claims:

pages 8 as originally filed/furnished

pages* NONE as amended (together with any statement) under Article 19

pages* NONE received by this Authority on _____

pages* NONE received by this Authority on _____

☒ the drawings:

pages none as originally filed/furnished

pages* NONE received by this Authority on _____

pages* NONE received by this Authority on _____

☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing

3. ☐ The amendments have resulted in the cancellation of:

☐ the description, pages _____

☐ the claims, Nos. _____

☐ the drawings, sheets/figs _____

☐ the sequence listing (*specify*): _____

☐ any table(s) related to the sequence listing (*specify*): _____

4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

☐ the description, pages _____

☐ the claims, Nos. _____

☐ the drawings, sheets/figs _____

☐ the sequence listing (*specify*): _____

☐ any table(s) related to the sequence listing (*specify*): _____

** If item 4 applies, some or all of those sheets may be marked "superseded."*

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.
PCT/US04/20862**Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1. Statement

Novelty (N)

Claims NONE YESClaims 1-8 NO

Inventive Step (IS)

Claims NONE YESClaims 1-8 NO

Industrial Applicability (IA)

Claims 1-8 YESClaims NONE NO

2. Citations and Explanations (Rule 70.7)

Claims 1-8 lack novelty under PCT Article 33(2) as being anticipated by US 6440431 to Yoshida et al (Yoshida).

Yoshida teaches cosmetic compositions in the form of emulsions. The compositions contain thickening agents, such as polyvinyl alcohol, guar gum, and sodium polyacrylates (col. 8, lines 25-30). The composition further comprises surfactants (col. 9, lines 40-63), pigments (tables 23 and 24). Further, Yoshida teaches that the thickening effect or the viscosity is a function of pH (col. 12) and suggests a pH of about 4 (col. 14). Table 10 further shows a viscosity that is within the claimed range. With respect to the limitation "soft, flexible and readily peelable film", the property claimed is inherent to the polyvinyl alcohol containing composition of Yoshida.

Claims 1-8 lacks an inventive step under PCT Article 33(3) as being obvious over US 6440431 to Yoshida et al (Yoshida).

Yoshida discussed above teaches composition containing the claimed polymer, thickeners, pigment and pH. Accordingly, preparing an emulsion containing the claimed ingredients and using for skin application such that a soft and peelable film is formed on the skin upon drying of the composition.

Claims 1-8 meet the criteria set out in PCT Article 33(4), and thus have industrial applicability because the subject matter claimed can be made or used in industry.

NEW CITATIONS

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.
PCT/US04/20862

Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

Continuation of: